

REMARKS/ARGUMENTS

Claims 1-18, 21, 22, and 37-52 were pending in the present application. Claim 2 was previously withdrawn and claims 19, 20, and 23-36 were previously cancelled. In the Notice of Non-Compliant Amendment, all claims were withdrawn as being directed to an invention that is distinct from that which was originally claimed. The amendment of October 7, 2008 was also considered non-responsive.

In response to the Notice of Non-Compliant Amendment, claims 1-18, 21, 22 and 37-52 have been cancelled. New claims 53-78 have been added. New claims 53-78 correspond to cancelled claims 1-18, 21, 22 and 37-52, therefore no new matter has been added. Reexamination and reconsideration of the pending new claims is respectfully requested.

The following remarks and arguments address the remainder of the Office Action of July 11, 2008.

Priority

The Office Action indicted that Applicants' priority claim to prior filed Application No. 10/637,713 failed to provide adequate support or enablement under 35 U.S.C. § 112 first paragraph and therefore the effective filing date of the present application for the purpose of applying prior art would be the actual filing date of the present application, and not that of the prior filed '713 application. The Office Action stated that the prior filed '713 application disclosed a stent having a slot that can be expanded by a catheter if the stent is deployed in a location covering a side branch (Office Action, pages 2-3). The Office Action further stated that the prior filed '713 application discloses that a balloon dilation catheter may perform the slot expansion, but the '713 application did not disclose that it would be the same balloon that expanded the stent in the main branch or that it would be the same balloon that would position the additional stents in the side branch (Office Action, page 3). Applicants respectfully request reconsideration of the effective filing date of the instant application for at least the following reasons.

The subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement. M.P.E.P. § 2163.02. To satisfy the written description requirement, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention as now claimed. An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. M.P.E.P. § 2163.02.

Fig. 1 of the earlier filed '713 application clearly shows a delivery catheter having a plurality of separable stent segments disposed over an expandable member. Figs. 7A-7E of the '713 application also illustrate use of this catheter in the treatment of multiple lesions with stents having customized length, without requiring removal of the delivery catheter from the patient. Paragraph [0100] of the '713 applications discloses:

circumferential slots 104 provide a pathway through which vessel side branches can be accessed for catheter interventions. Should stent segment 32 be deployed at a location in which it covers the ostium of a side branch to which access is desired, a balloon dilatation catheter may be positioned through circumferential slot 104 and expanded. This deforms circumferential struts 109, 111 axially outward, thereby expanding circumferential slot 104 and further expanding upper and lower slots 102, as shown in phantom in Fig. 3B. This provides a relatively large opening 120 through which a catheter may be inserted through stent segment 32 and into the side branch for placing stents, performing angioplasty, or carrying out other interventions.

Paragraph [0104] of the '713 application also discloses:

It should also be noted that the embodiment of Figs. 6A-6B retains the feature described above with respect to Figs. 5A-5B to enable access to vessel side branches blocked by stent segment 32. Should such side branch access be desired, a dilatation catheter may be inserted into circumferential slot 128 and expanded to provide an enlarged opening through which a side branch may be entered.

Thus it is clear that the earlier filed '713 application discloses a catheter for treating multiple lesions without requiring removal of the catheter from the patient. The '713 application also discloses treating a main vessel lesion and a bifurcation lesion. While perhaps not expressly stating that both the main vessel lesion and the bifurcation lesion are stented using the same catheter, one of ordinary skill in the art would appreciate that the catheter could be used to treat both branches without removing the catheter from the patient.

Therefore, Applicants respectfully request that the effective filing date of the present application be modified to include the priority claim to the earlier filed '713 application, which was filed August 8, 2003.

Claim Objections

Claim 12 was objected to for having the negative recitation "is not removed from." Claim 12 has been cancelled thereby obviating the objection. New claim 64 has been added and corresponds to cancelled claim 12. Per the Examiner's suggestion, claim 64 recites "remains in." Claim 1 has also been cancelled and new claim 53 added with similar terminology.

Claim 12 was also objected to for lack of antecedent basis in the phrase "between deploying the first and second stents" because the previously recited step of "deploying" was removed in a prior amendment. Claim 12 has been cancelled thereby obviating the objection. New claim 64 has been added and corresponds to cancelled claim 12. Claim 64 recites "between radially expanding." Claim 1 has also been cancelled and new claim 53 added with similar terminology.

Claims 19 and 20 were objected to as being unclear about whether the step of "expanding an expandable member" finds antecedent basis in the "expanding" step of claim 12. Claims 19 and 20 have been cancelled thereby obviating the objection.

Claims 38 and 39 were objected to as being unclear whether the limitation "selecting" finds antecedent basis in the "selecting" step of claim 37. Claims 38 and 39 have been cancelled thereby obviating the objection. New claims 74 and 75 have been added and recite "the step of selecting" as suggested by the Examiner.

Claims 41 and 42 were objected to as being unclear whether the step of "selecting" finds antecedent basis in the "selecting" step of claim 40. Claims 41 and 42 have been cancelled thereby obviating the objection. New claims 77 and 78 have been added and recite "the step of selecting" as suggested by the Examiner.

Claim Rejections – 35 U.S.C. § 103

Chermoni in view of Brucker

In the Office Action, claims 1, 3-10, 12, 13, 17-21, and 37-42 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chermoni (U.S. Patent Publication No. 2002/0156496), in view of Brucker (U.S. Patent Publication No. 2002/0193873). Such rejections are overcome for at least the following reasons.

Claims 1, 3-10, 12, 13, 17-21, and 37-42 have been cancelled thereby obviating the rejection. New claims 53, 55-62, 64, 65, 69-71, and 73-78 have been added and correspond to cancelled claims 1, 3-10, 12, 13, 17-21, and 37-42, therefore no new matter has been added.

New claims 53, 55-62, 64, 65, 69-71, and 73-78 are believed to be patentable over the cited references for at least the following reasons. Independent claim 53 recites in part the step of positioning a delivery catheter in the main branch, the delivery catheter having an expandable member disposed thereon and first and second stents unconnected with one another and positionable over the expandable member in direct engagement with one another when unexpanded. (Emphasis added). Support for this may be found *inter alia* in paragraph 060 and Fig. 1 of the application as filed, therefore no new matter has been added. Neither Chermoni nor Brucker teach or suggest this feature of the claimed invention.

Chermoni discloses a catheter configured to carry one or more stents, however, the stents are separated from one another by a separating ring (e.g. 208a, 208b, 208c in Fig. 2) or the stents are disposed in annular depressions separated by a barrier (e.g. 620a in Fig. 6). Because the stents are separated from one another, Chermoni fails to teach or suggest first and second stents unconnected with one another and positionable over the expandable member in direct engagement with one another when unexpanded, as recited by claim 53. Brucker also fails to teach this feature.

Brucker discloses a catheter having two stents disposed over two separate balloons which are separated from one another (see Fig. 18). Brucker fails to teach or suggest engaging the stents with one another or placing two stents over a single balloon. Therefore, Brucker also fails to teach or suggest first and second stents unconnected with one another and positionable over the expandable member in direct engagement with one another when unexpanded.

Because the cited references, alone, or in combination fail to teach or suggest each and every element of the claimed invention, claim 53 and the claims depending therefrom are believed to be patentable over the cited references.

Claim 12 has been cancelled and new claim 64 added. Claim 64 corresponds to cancelled claim 12 and recites similar features as claim 53, therefore for at least the same reasons discussed above, Applicants believe that claim 64 and the claims depending therefrom are patentable over the cited references.

Claim Rejections - 35 U.S.C. § 103

Chermoni in view of Brucker and Loos

Claims 14-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chermoni (U.S. Patent Publication No. 2002/0156496), in view of Brucker (U.S. Patent Publication No. 2002/0193873) and further in view of Loos et al. (U.S. Patent No. 6,579,309). Such rejections are overcome for at least the following reasons.

Claims 14-16 have been cancelled thereby obviating the rejection. New claims 66-68 have been added and correspond to cancelled claims 14-16. New claims 66-68 are believed to be patentable for at least the following reasons. New claims 66-68 depend from independent claim 64 which has been distinguished from Chermoni and Brucker as described above. Loos fails to provide the elements missing from Chermoni and Brucker.

Loos discloses a single stent for implantation in the region of a vessel branching (Abstract). Since there is only one stent in Loos, Loos fails to teach or suggest a delivery catheter having an expandable member disposed thereon and first and second stents unconnected

with one another and positionable over the expandable member in direct engagement with one another when unexpanded, as recited by claim 64.

Because the cited references alone or in combination fail to teach or suggest each and every element of the claimed invention, claims 66-68 are believed to be patentable over the cited references.

Chermoni in view of Brucker and Shaknovich

Claims 11 and 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chermoni and Brucker and further in view of Shaknovich (U.S. Patent No. 5,807,398). Such rejections are overcome for at least the following reasons.

Claims 11 and 22 have been cancelled thereby obviating the rejection. New claims 63 and 72 have been added and correspond to cancelled claims 11 and 22. Claims 63 and 72 depend from independent claim 53 and 64, respectively, both of which have previously been distinguished from Chermoni and Brucker as discussed above. Shaknovich fails to provide the elements missing from Chermoni and Brucker.

Shaknovich discloses a stent delivery system comprising a shuttle onto which several stents are disposed (Abstract). In Shaknovich, the stents are flanked by a non-expandable portion of the shuttle (e.g. 5 in Fig. 9) therefore the stents are separated from one another and thus are not in direct engagement with one another when unexpanded, as recited by claims 53 and 64. Moreover, even if a stent in Shaknovich is considered to be two stents, the two are connected together, contrary to claims 53 and 64 which recite that the first and second stents are unconnected with one another.

Because the cited references, alone or in combination, fail to teach or suggest each and every element of the claimed invention, claims 63 and 72 are believed to be patentable over the cited references.

Appl. No. 10/814,593
Amdt. dated February 6, 2009
Reply to Office Action of January 13, 2009

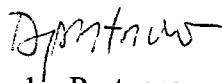
PATENT

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,


Douglas Portnow
Reg. No. 59,660

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 650-326-2400
Fax: 415-576-0300
Attachments
D3P:jar
61798938 v1